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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,396	03/19/2001	Peter Holscher	SCH 1706	2405

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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,396

Applicant(s)

HOLSCHER ET AL.

Examiner

John M. Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1--15 is/are pending in the application.
- 4a) Of the above claim(s) 11--15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1--10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

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Applicants' election of Dec. 20, 2001, is noted.

Applicants elected the instances in claim 1 where X is O the benzoxazines.

This is a 371 application. 37 CFR 1.475 controls the restriction to one product. Thus, the restriction. There is only time to search one invention X being S(O)m or Se are different inventions, not supported here.

Claim 1 is rejected under 35 U.S.C. 112, 2nd paragraph. X is not defined as the elected one solely- look at the last 5 lines of claim 1. Claim 1 needs to be re-written in view of the election. What is the purpose of the proviso "not" --? Is not being written around? Applicants cannot prevail in a Unity of Invention argument when some species are being removed.

The restriction is considered sound and proper, and will be maintained.

Claiming should be alternative or - or - or -. Not the and -- and of the first several lines. It is suggested that lines 1 and 2 be replaced with: A compound selected from the group consisting of the compounds of Formula I, their tautomeric and isomeric forms and salts.

Claim 1 is rejected under 35 U.S.C. 112, 1st and 2nd paragraphs.

One finds, at the top of page 2 of claim 1 "5 or 6 membered heteroaryl with 1 to 4 oxygen, sulfur or nitrogen atoms". What is that? An R3? Please add "or R3 is" to the first of the lines. If they are R3.²

The heteroaryl appears again lines 5-6 of that page with all hetero atoms. The again at line 5 with 1--3 N, O or S, Q, U, "R8 and B" and "R7 and A" each contain (an open term) open heterocyclic expressions as does R11 and "R15 and R16", what applicants intend to claim is not

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17991502 421 423 (CCPA 1973)

clear; See In Wiggins, It remains unclear where the hetero atoms are in the rings. Each combination is separately classified and searched. Adjacent O/S or S/S or O/O combinations are notoriously unstable. In some instances what the hetero atoms are, is not noted: in other the open "contain" permits any atoms other than carbon to be present.

Applicant are claiming compounds that have not yet been made, why should applicants be permitted to preempt work of other that may find ways to change the bond angles to reduce the strain in the ring such that rings that have not yet been produced, might, in the future, be made. Applicants have not shown a source of the starting materials, this is, in any way, representative of all of the rings they claim. It is not clear what rings applicants are claiming. The reader should not be put to drawing out all of the possible rings, in order to search, when it is apparent applicants did not make them.

Obviously, 5-or-6-membered heteroaryl could not be allowed. (Page 2 of claim 1). What hetero atoms are present? Located where in the ring(s)? A search requirement.

A list, in the claims, of the rings intended to be claimed is going to be necessary.

Where is, what is intended by applicant, supported in the specification with sufficient representative exemplification? Note United Carbon Co. v. Binney Smith Co. 55 U.S.P.Q. 381, Supreme Court of the United States (1942) "an invention must be capable of accurate definition, and it must be accurately defined to be patentable" above at page 386.

These are compound claims, one must clearly know what is being claimed.

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Assuming that applicant is claiming what he regards as his invention, there are in reality only two basic ground of rejecting claim under 35 U.S.C. 112, first is that language used is not precise enough to provide ^{a clear} cut indication of scope of subject matter embraced by claim; this ground finds its basis in second paragraph of second 112, second is that language is so broad that it causes ^{the} claim to have a potential scope of protection beyond that which is justified by ^{the} specification disclosure; this ground stems from ^{the} first paragraph of section 112, merits of ^{the} language in claim must be tested in light of these two requirements. The heterocyclic or heteroaryl variable is not believed to meet the requirements of 35 U.S.C. 112, first and second paragraphs. The heterocyclic variable is not precise and definite enough to provide a clear-cut indication of the scope of the subject matter embraced by the claim. The heterocyclic ring expression is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure.

The written disclosure is considered inadequate herein the specification. Conception should not be role to the reader. Applicants should, in return for a 17/20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35 U.S.C. 112, first and second paragraph rejection. If you (the public) find that it works, I claim it; is not a proper basis for patentability In re Kirk, 153 U.S.P.Q. 48 at page 53.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co. 55 U.S.P.Q. 381 at 384, col. 1, end of first paragraph, Supreme Court of the United States (1942).

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The U.S. Court of Claims held to this standard in *Lockhead Aircraft. vs. Unites States*, 193 U.S.P.Q. 449, "Claims measure invention and resolution of invention must be based on what is claimed.

The CCPA in 1978 held: "that invention is the subject defined by the claims submitted by the applicant". We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitations is included in the claim': In re Priest 199 U.S.P.Q. 11, at 15.

Heterocyclic or heteroaryl is capable of varied definition. The USPTO only recognize C,O,N,S,Se,Te as members of a hetero ring. Other definitions include As, P and B. What do applicants intend? The type of omnibus expression was rejected in In re Wiggins, 179 U.S.P.Q. 421. Wiggins was cited with approval in In re Oetiker 23 U.S.P.Q. 2nd 1661 at 1662 col. 2, because the scope of the claims is unclear.

Claims 2 --5 are rejected under 35 U.S.C. 112, 2nd paragraph. It is suggested that the leader be: A compound according to claim 1.

Claims 4, 5, 6 and 8 are rejected under 35 U.S.C. 112, 5th paragraph. A multiple dependent claim, may not be dependent on a multiple dependent claim.

Claim 6 is not written in U.S. claim form, "Preferably" is not acceptable, as it claims a genus and a sub genus, in the same claim.

Compounds need be changed to: A compound -- in claims 7 and 8 and 9.

Claim 10 does not comply with 37 CFR 1.141.

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In 1964, when I started, here, as an Examiner, there was a no more than 5 species requirement in Rule 141. That was changed to a reasonable number. Then the word "different" was inserted to specify that each species had to be in a different claim, so the USPQ would not lose so much money on the claim.

Claim 11 is an aggravated, multiple page, example of listing ultimate species in one claim, as if to avoid fees. 37 CFR 1,141(a) is (the Rules) said by In re Fressola to have the force law, 22 USPQ 2nd 1828.

Applicants paid \$18.00 for claim 10. Each CAS-on-line search for each individual species cost \$35.00.

Claims 11 --15 stand with ^{subject} drawn as being directed to non-elected matter.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

A single page "Abstract" is requested on one single, separate page. A photo-gravure process is used.

The 371 goes back to 16 Sept. 1999, but the ^{only} 371 is only said to ^{be} identical to the English national application, that requirement of being identical does not carry back to German application 19844291.2.

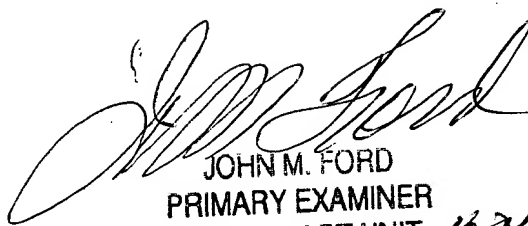
Therefore, a certified English translation of German application 19844291.2 is needed here to remove WO/98/50372 as being a reference here.

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Claims 1--10 are rejected under 35 U.S.C. 103, as being unpatentable over WO/98/50372, which has a 12 November 1998 publication date. Note, the present invention is noted in formula I, in the *tautomeric* in-amine form.

J. Ford:jmr

Feb. 11, 2002


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624